Hovsepian v. Apple, Inc. Doc. 241

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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF ITS RESPONSE TO THE COURT'S REQUEST FOR ADDITIONAL BRIEFING REGARDING CLAIMS 45 AND 46 OF THE '992 PATENT** DATE: August 17, 2007 TIME: 9:00 a.m. CTRM: Hon. James Ware

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I. INTRODUCTION

Acacia hereby addresses two issues for which the Court sought additional information: (1) whether claim 45 of the '992 is indefinite; and (2) what is the order of the steps of claim 46 and whether there is an error in the specification of the '992 patent at 17:44-53. These issues are not reconsideration issues.

II. CLAIM 45 OF THE '992 PATENT

A. Claim 45 Is Not "Arguably Indefinite"

The Court's tentative conclusion that claim 45 of the '992 patent may be indefinite results from the Court's factual misapprehension that there is no description of storage of multiple files in the '992 patent specification. (3rd CCO, p. 33). There is such disclosure, and the phrase in claim 45 of "separately storing a plurality of files" would have been understood by persons skilled in the art when claim 45 is read in light of the specification. *Bancorp Serv., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004).

In its 3rd CCO, the Court considered claim 45 of the '992 patent and stated that the specification does not describe storage in multiple files, but instead only describes storing a single file with the compressed, sequenced data blocks, citing 10:23-26 and 10:36-39. (3rd CCO, p. 33). In determining that the specification does not describe "storage" in multiple files, the Court cites two sentences from the specification. ('992 patent, 10:23-26 and 10:36-37). These sentences relate to the "compressed data storage means 117," which performs the function of creating the file. The Court does not refer to any of the other structures described in the specification in which the ***storage*** of multiple files occurs – namely, the short term storage section 117 of the compressed data storage means 117, the compressed data library 118 and the storage device in the receiving system. (Weiss Decl., ¶¶ 20-23). For example, the specification states that the file created by the compressed data storage means 117 is stored in the compressed data library 118, ***together with a plurality of other files***.[1] ('992 patent, 10:36-45).

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[1] The specification further describes how, from the plurality of files stored in the compressed data library 118, any particular file (referred to as an item) is accessed using the file address, thus further demonstrating that multiple files are stored in the compressed data library 118. ('992 patent, 10:36-

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The Court also appears to be interpreting claim 45 to require that the data blocks for one item be stored in multiple files. This is not what is described in the specification or in claim 45. In the specification, each item is assigned one unique identification code and each item, together with its unique identification code, is stored. ('992 patent, 6:35-39). Indeed, in claim 41, from whence claim 45 depends, the information retrieved from each item having information is assigned a unique identification code and the file created from the compressed data blocks for that item is stored (i.e., retained in the compressed data library) with the unique identification code.

III. CLAIM 46 OF THE '992 PATENT

A. The Order of the Steps of Claim 46

In its 3rd CCO, the Court considered claim 46 of the '992 patent. Claim 46 depends from claim 45, which depends from claim 41. The Court requested further briefing on the sequence of claim 46, particularly with respect to "when the element generating the 'list of available items' takes place." (3rd CCO, p. 33).

In their Joint Chart of the Parties' Proposed Definitions for Claim Terms From the '992 and '275 Patents (Document No. 147, filed April 17, 2006, at p. 11), the parties set forth their positions on the order of the steps of claim 46. All parties were in agreement that the steps of claim 46 are performed in the order in which they appear in claim 46. (See also, Weiss Decl., at ¶ 26).

The Court specifically asked when the step of "generating a listing of available items" occurs. Claim 46 does not specify when this step must occur, other than specifying that it must occur prior to the second step of claim 46, i.e., prior to "receiving transmission requests to transmit available items." The patent specification also does not specify when this "generating" step must occur, other than stating that it must occur prior to the system receiving a transmission request from the user. (*See,* '992 patent, 3:54-60).

Persons of ordinary skill in the art would also have understood that the list of available items likely would not have been generated until there existed available items that could be requested by the user. (Weiss Decl., ¶¶ 27-28). The specification describes two instances wherein user requests

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are made for items: (1) a user may make a request for an item in the source material library and causing the item to retrieved, formatted, compressed, and stored ('992 patent, 18:53-19:10); and (2) a user may make a request for items that have already been formatted, compressed, and stored in the compressed data library. ('992 patent, 13:29-47). (*Id.*) Thus, the only other limitation on the sequence of the "generating" step is that it occur after there are available items in the transmission system, i.e., after they are stored in the source material library, after they are stored in the compressed data library or after items are known to be available in the future. (Weiss Decl., ¶¶ 27-28).

Accordingly, the step of "generating a listing of available items" of claim 46 occurs prior to the step of "receiving transmission requests to transmit available items" and after either the items having information are stored in the source material library or after the files having the compressed, formatted, sequenced data blocks are stored.

B. The Error in the Specification at 17:44-53

Although not a claim construction issue, the Court stated in its 3rd CCO that it required further briefing to determine whether the portion of the specification at 17:44-53 includes an error. The Court questions whether the reference to "[t]he library access interface 121 in the reception system 200 preferably includes a title window where a list of available titles are alphabetically listed" should actually refer to the transmission system in Figure 2b.

This is indeed an error in the specification, however, the correction should not be to refer to the transmission system. Instead, this section is describing features of the reception system 200, which is depicted in Figure 6. (Weiss Decl., ¶ 30). As shown in Figure 6, there is a "user/computer interface" (reference no. 207) from which the user can send communications to the transmission system and from which the user can interact with the reception system. (See, Figure 2b).

The listing of content available on the system is made available to users through control computer 1123, whether that information resides on the control computer or on the remote order processing and item database 300, as described at 11:66-12:7 and 17:51-53. The information from control computer 1123 is distributed to users through library access interface 121 in the transmission system 100. One of the places where the information from the transmission system can be presented

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to the user is through one of the specialized interfaces built into the reception system 200. Given all this, persons of ordinary skill in the art would have understood the paragraph in question in column 17 as though its first sentence had been written as follows: "The information distributed by the library access interface 121, when presented by the reception system 200, preferably includes a title window where available titles are alphabetically listed." (Weiss Decl., ¶ 31.)

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